

Amendment
Serial No. 10/619,995

REMARKS

Claims 1, 2, and 4 are pending. Claims 1, 2, and 4 stand rejected. Claim 1 is an independent claim.

The specification stand objected under 37 C.F.R. 1.75(d)(1) and MPEP §608.01(o) as allegedly failing to provide proper antecedent basis for the claimed subject matter.

The Applicant redrafts claim 1 to conform the language of claim 1 to idiomatic English. The Applicant, however, did not add additional feature to claim 1, and the Applicant retained the same scope. The amended portion of claim 1 appears below with inserted citations of support.

1. An apparatus for drawing an optical fiber comprising:
 - a control unit that includes a calculation unit, the calculation unit being
 - configured to receive a drawing speed signal output from the capstan (the original claim 1; the specification, at page 5, line 13-15);
 - configured to calculate a slope of the drawing speed during a previous time period (the specification, at page 5, line 15-16 ("period before the present period"));
 - configured to obtain an expected drawing speed of a future time using the calculated slope (id. at line 16-17 ("obtain an expected drawing speed of [a...] time later"));
 - configured to estimate a first compensation value according to a difference between a present drawing speed and a target drawing speed (id., at line 17-18);
 - configured to estimate a second compensation value according to a difference between the present drawing speed and the expected drawing speed of the future time (id. at line 19-20); and
 - configured to calculate a preform feed speed based on the estimated compensation values, (id. at line 20-21)
 - wherein the control unit is configured to control the outer diameter of the optical fiber using the calculated preform feed speed (page 12, line 8 – page

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13, line 17).

According to 37 C.F.R. 1.75(d)(1) and MPEP §608.01(o), the claims are proper if the claims use phrases that have antecedent bases OR clear supports in the specification (see id.).

Meanwhile, 35 U.S.C. 112, second paragraph, defines the claim as a part of the specification by stating that the “specification shall CONCLUDE WITH one or more claims” (see also *In re Gardner*, 480 F.2d 879, 879-880, 178 USPQ 149 (CCPA 1973) (the Patent Office admitting that an original “claim may be considered as a part of the original disclosure”)).

In raising the objection, the Patent Office indicates that “there is no antecedent basis in the specification for (1) the ‘second preform feed speed,’ (2) the ‘second compensation value,’ (3) any part of the apparatus being ‘configured to,’ (4) the ‘first feed speed,’ (5) the ‘previously arbitrary period of time,’ (6) the ‘future period of time,’ and (7) the ‘first compensation value’” (the present Office Action page 3).

As noted above, each of the amended features related to the calculation unit including the first and second compensation values; the preform feed speed; the previous period; and the future time are fully supported by the specification at, among others, page 5-6, and in the original claims 1-4.

Moreover, other features recited claim 1, as well as the feature recited in claims 2 and 4, are fully supported in, among others, the original claims 1-4 of the specification.

Furthermore, the specification clearly supports each of the components of the apparatus of claims 1, 2, and 4 being “configured to” perform particular functions recited in the claims by disclosing that the apparatus performs such functions (see the specification at page 5-6; see also the original claims 1-4). It is apparent that the apparatus must be configured to perform functions in order to perform the functions. Otherwise, the apparatus will not be able to perform the function.

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Therefore, the specification clearly supports for each of the features listed in the present claims, and the specification complies with 37 C.F.R. 1.75(d)(1) and MPEP §608.01(o).

The Applicant respectfully requests withdrawal of the objection.

Claims 1, 2, and 4 stand rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite.

In rejecting the present claims, the Patent Office indicates that “the invention appears to be completely different from what is disclosed in the specification” (the present Office Action, page 3). “Using the plain meaning of the claims (when read in light of the specification) it appears to the Examiner that the disclosed invention/embodiment is outside the claims” (id.). To support, the Patent Office cites the holding of *Vitronics Corp., v. Conceptronic, Inc.*, 90 F.3d 1576, 1583-4, 39 USPQ2d 1573 (Fed. Cir. 1996).

In addition, the Patent Office indicates that the two compensation values according to claim 1 appears to differ from the compensation values described in the description portion of the specification, at page 11. The Patent Office also indicates that “there is no disclosure of any ‘previously arbitrary period of time’ or a ‘future arbitrary time period’” (id.).

The Patent Office also indicates that “the specification refers to using ‘expected deviations’ – but there is none claimed, [and that] the claims refers to a ‘expected drawing speed’ – but none is utilized in the disclosed embodiment” (id.).

Further, the Patent Office indicates that “there is confusing antecedent basis for ‘the arbitrary time’[; that] it is unclear if it is the future or the one that was ‘previously arbitrary’[; and that] it is unclear if arbitrary ‘time’ is the same thing as the arbitrary ‘period of time’” (id.).

The Applicant traverses the rejection on several grounds.

First, in *Vitronics*, The United States Court of Appeals for the Federal Circuit held that a

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third party's interpretation of a feature, for purpose of determining infringement, are often incorrect, if the interpretation would place an embodiment outside the scope of the patent claim (90 F.3d at 1583 (holding that the interpretation of "solder reflow temperature" as "liquidus temperature," as argued by the alleged infringer, is an incorrect interpretation, as such interpretation would place the embodiment outside the scope of the claims)).

By rejecting the present claims as being indefinite based on the belief that its interpretation would place the embodiment outside the scope of the claim, and by citing *Vitrionics*, the Patent Office neither asserts nor demonstrates that claims 1, 2, and 4 are indefinite. The Patent Office, instead, is acknowledging that (1) its own interpretation of the present invention is an incorrect interpretation, and that (2) the present rejection is based on the Patent Office's incorrect interpretation.

The Applicant submits with utmost respect that none of the patent statutes, the case laws, the patent rules, and the MPEP permits the Patent Office to deny a patent based solely on the Patent Office's incorrect interpretation of the invention. As such, the present rejection is improper.

Second, as noted above, each of the features recited in claims 1, 2, and 4 is clearly supported by the specification, at, among others, page 5-6, and in the original claims 1-4.

Third, the Federal Circuit explicitly held that "it is familiar principle of patent law that a claim need not be limited to a preferred embodiment" (*Cordis Corp. v. Medtronic Ave., Inc.*, 339 F.3d 1352, 1365 (Fed. Cir. 2003)). The embodiments described in the description portion of the specification are merely EXAMPLES of the invention (see *Gart v. Logitech, Inc.*, 254 F.3d 1334, 1342, 59 USPQ2d (Fed. Cir. 2001) (noting that "drawings [illustrating the preferred embodiment] are not meant to represent 'THE' invention.")).

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Moreover, the section 2173.01 of the MPEP expressly allows the patent applicant to recite features "whatever terms" the applicant chooses, so long as the applicant sets forth any special or out of ordinary meaning assigned to a term.

As the embodiments are merely examples of the invention, the claims and the embodiments may have different features (see *Cordis Corp.*, 339 F.3d at 1365; *Gart*, 254 F.3d at 1342). In addition, as the patent applicant may use "whatever terms," claims and the embodiments may use different nomenclatures (MPEP 2173.01). The Applicant respectfully submits that differences in the features and/or the nomenclatures do not constitute grounds to invalidate the claims under 35 U.S.C. 112, second paragraph (see *id.*).

As such, the present claims need not include the feature or the nomenclature "the expected deviation," as alleged by the Patent Office. At the same time, the embodiments, as examples of the present invention, need not recite the "expected drawing speed."

Fourth, the Applicant harmonizes the nomenclatures of the "future arbitrary times period" and the "arbitrary time later" into the "future time" in response to the objection to the specification (see above). In the process, the Applicant also distinguishes the "future time" from the "previous time period."

As such, confusion does not arise from the recitation of "future time" and the "previous time period."

As noted on the foregoing remark, claims 1, 2, and 4 are definite and do not violate any requirement set forth in 35 U.S.C. 112, second paragraph.

The Applicant respectfully requests withdrawal of the rejection.

Other claims in this application are each dependent on the independent claim 1 and believed patentable for the same reasons. Since each dependent claim is also deemed to define

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an additional aspect of the invention, however, individual consideration of the patentability of each on its own merits is respectfully requested.

Should the Examiner deem that there are any issues which may be best resolved by telephone, please contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,



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